

## RESPONSE TO OFFICE ACTION

This responds to the Office Action dated January 12, 2021 concerning the application for SINSATIONAL BY FUTURE. Applicant hereby submits the following remarks below in support of registration. The Examining Attorney has refused registration on grounds that the Cited Registrants' Mark under No. 5554424 (the "'424 Reg.") in Class 3 may present a bar to registration under Trademark Act Section 2(d) on the grounds that Applicant's mark, when used in connection with Applicant's goods, so resembles the Registered Mark that consumer confusion is likely. Applicant respectfully disagrees with the Examining Attorney and argues the following.

### INTRODUCTION

Applicant NFH Fragrance House Inc. notes that it is the owner of certain trademark rights associated with the widely-renowned performing and recording artist Future, whose rise to prominence over the past several years has given rise to immense success and fame since his first mixtape recordings were heard and gained widespread recognition and approbation by audiences in the United States and throughout the world.

Future's renown speaks for itself: he has eight studio albums since 2012, and several collaborative mixtapes, as well as appearing as a featured guest on countless singles by third-party artists. He has toured extensively throughout the United States, including no fewer than two blockbuster tours of large indoor- and outdoor venues where he was the featured headliner. When consumers with even a passing familiarity with contemporary rap and R&B music see the name FUTURE, or "BY FUTURE", they immediately think of Future; when they see it in connection with cosmetics and fragrances, they think of Applicant.

The Cited '424 Reg. for the mark SINSATION covers certain cosmetics in Class 3, and cosmetic brushes etc. besides.

Applicant has a well-established record of ongoing, continuous use of the FUTURE / "BY FUTURE" mark in such a tremendously successful manner that beggars the idea that any consumer throughout the United States would likely be confused as between its use of SINSATIONAL BY FUTURE and the substantially different SINSATION mark in the Cited Registrants. Thus, the Section 2(d) refusal is inappropriate and should be withdrawn.

### REMARKS

#### **I. Confusion Must Be Probable, Not Possible.**

It is well established that for confusion to be likely, the confusion must be probable; it is irrelevant that confusion is merely possible. *Electronic Data Sys. Corp. v. EDSA Micro Corp.*, 23 USPQ 2d 1460, 1465 (TTAB 1992) (standard is likelihood of confusion, "not some theoretical possibility built on a series of imagined horrors"); *Rodeo Collection, Ltd. v. West Seventh*, USPQ 2d 1204, 1206 (9 Cir. 1987) ("probable, not simply a possibility"). Trademark law is "not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal." *Electronic Design &*

*Sales, Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d 1388 (Fed Cir. 1992), quoting *Witco Chem. Co. v. Whitfield Chem. Co.*, 164 USPQ 43, 44-45 (1969). For the reasons outlined below, Applicant respectfully argues that confusion is highly unlikely in this instance and therefore the refusal should be reversed.

## **II. Confusion Is Unlikely With the ‘424 Reg. Because the Goods Are Distinct.**

It is irrelevant that the goods may be tangentially related by their characterization in Class 3. Rather than this or similarly reductive semantic generalization of the products, it is consumer perception that is significant for determining product relatedness. *See, e.g., Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ 2d 1460, 1463 (TTAB 1992) (“[T]he issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category”); *UMC Industries, Inc. v. UMC Electronics Co.*, 207 USPQ 861, 879 (TTAB 1980) (“the fact that one term, such as ‘electronic,’ may be found which generally describes the goods of both parties is manifestly insufficient to establish that the goods are related in any meaningful way”); *Harvey Hubbell, Inc. v. Tokyo Seimitsu Co.*, 188 USPQ 517, 520 (TTAB 1975) (“In determining whether products are identical or similar, the inquiry should be whether they appeal to the same market, not whether they resemble each other physically or whether a word can be found to describe the goods of the parties”).

### **a. Applicant’s and Registrant’s Goods Are Distinct.**

Applicant’s Mark SINSATIONAL BY FUTURE is used with a particular perfume, in whose formulation Future played a role. Applicant’s goods in Class 3 have been amended to reflect this. By contrast, Registrant’s Mark SINSATION is used with a range of high-end cosmetics (powders, mascaras, and the like) and what appear to be high quality brushes and applicators therefor.

Any consumer viewing both Applicant’s and Registrant’s Marks in their respective use in the market, will likely perceive that these are two entirely different marks, as the goods associated with the marks are substantially different. Applicant’s Mark specifically references FUTURE as the creator of the product. Notwithstanding their relatedness by dint of being in the same Class, there are nonetheless substantial differences in the types of goods, and the sophistication of the respective target purchasers of these high-end, luxury-priced products strongly suggests they understand their purchasing choices. There is no likelihood of confusion because the goods sold by the Applicant and the Cited ‘424 Registrant are simply – and substantially – different.

## **III. Applicants and the Cited Registrants Marks Must Be Viewed In Their Entirety.**

### **a. Applicant’s Mark Is Visually And Aurally Different Than Registrant’s Mark.**

Applicant’s mark is SINSATIONAL BY FUTURE a three-word, seven-syllable phrase whose first word is an adjective. By contrast, the Cited Registrant’s mark is

SINSATION, which comprises a single word in three syllables, and which is a noun. Both marks' initial terms are plays on "SENSATIONAL" / "SENSATION", and this is instructive, as one might say, "You're sensational!" but not "You're sensation!", just as one might say, "Feel the sensation!" but not "Feel the sensational!" Because the respective marks' base terms are thus grammatically impossible to confuse in use, they create considerably distinct commercial impressions. When the further-source-identifying "BY FUTURE" is included, the distinction between the marks is complete and certainly not subject to confusion by the sophisticated target consumer of the respective goods offered by Applicant and the Cited Registrant. These are not impulse purchases, nor are they low-priced bargain bin mass-market items. The pricing and the marketing reflect this clearly, as evidenced in the specimens of record in the '424 Registration's file history, as well as on its website.

The terms "SINSATIONAL BY FUTURE" comprise Applicant's Mark, and it would therefore be improper to dissect the mark for the purpose of making it easier to conclude the marks are confusingly similar. *In re National Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP 1207.01(b)(iv) ("[L]ikelihood of confusion cannot be predicated on dissection of a mark . . . the ultimate conclusion rests on consideration of the marks in their entireties."). This is especially so where, as here, the phrase "BY FUTURE" imbues Applicant's mark with particular and substantial meaning to its target consumer market, emphatically associating the fragrance with the performing artist Future and thus distinguishing its goods from the goods offered under the Cited Registrant's SINSATION mark, and a comparison of the two marks leads to the same conclusion that confusion is unlikely, as shown herein. *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion, because the word "BOBBER" has different connotation when used in connection with the respective goods and services).

The Examining Attorney must consider the overall impression of Applicant's and Registrant's Marks rather than just the similar portion. The substantial visual and aural differences, especially in light of extant consumer understanding of who Applicant is, allows consumers to easily distinguish the marks and avoid confusion. *See Land-O- Nod Co. v. Paulis*, 220 USPQ 61 (TTAB 1983) (holding that CHIRO-MATIC and CHIROPRACTIC are not confusingly similar as applied to identical goods); *In re General Electric Co.*, 134 USPQ 190,191 (CCPA 1962) (holding that VULKENE and VULKAN are not confusingly similar for the "same goods").

Even if the marks are found to be visually or aurally similar – which Applicant emphatically does not concede, one factor of similarity is not determinative in a likelihood of confusion analysis. "Similarity of the marks in one respect- sight, sound or meaning- will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related." *In re Lamson Oil Co.*, 6 USPQ 2d 1041, 1043 (TTAB 1987). *See also* TMEP 1207.01(b)(i). More important, one mark's phonetic similarity to another mark is not dispositive in a likelihood of confusion analysis. *See Standard Brands, Inc. v. Eastern Shore Canning Co.*, 172 F.2d 144, 146 (4th Cir. 1949)

(finding that the “phonetic similarity of the two marks cannot prevail” in a trademark infringement analysis when there is no evidence of actual confusion between the marks V8 and VA); *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312, 1320 (TTAB 1987) (reversing the refusal to register CROSS-OVER for bras and CROSSOVER for ladies’ sportswear); *Blue Man Productions v. Erich Tarmann*, 75 USPQ2d 1811, 1849 (TTAB 2005) (finding no likelihood of confusion between the marks BLUEMAN and BLUE MAN GROUP). This is especially true when, as here, the way consumers encounter a mark *obviates* the one respect in which two marks are similar.

#### **b. Applicant’s Mark Is Different In Meaning and Connotation Than Registrant’s Mark.**

Similarity in meaning or connotation is a factor in determining whether marks are confusingly similar. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362; 177 USPQ 563, 567 (CCPA 1973); *see also San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2-3 (CCPA 1977) (“Obviously, the marks here... must be considered as wholes, and not on the basis of side-by-side comparison....”).

As discussed above, SINSATION is a term that invites questions and interpretations. Is the Cited Registrant invoking what one might become when one wears its cosmetics? This and countless other questions and possibilities come to mind when consumers confront the Cited Registration. Indeed, the Registrant and its target market may understand the message behind the mark. However, by contrast, Applicant’s SINSATIONAL BY FUTURE raises different questions: does it engender a feeling? Is it a scent that creates an outstanding and multisensory impression of the wearer when worn? More importantly, there is no evidence that ordinary consumers would not understand or perceive the clear distinction in the marks. As a result, the Cited Registrant’s mark is more aptly understood as suggesting something different in meaning and origin from that of Applicant’s mark.

#### **IV. Previous Marks Granted With Much More Similar Names**

Previous Trademark Applications have been granted Registration over prior Registered Trademarks where the mark and/or the applied for goods and/or services were much more similar to each other than is found between Applicant’s mark and the Registrant’s mark. For example, the following four Registered U.S. Trademark Nos. 3,113,039 for “VEX”, 3,581,344 for “HI-VEX”, and 1,240,921 for “SOLVEX”, each of which includes goods in International Class 009, all include the characters “V-E-X.” Because all four of these Trademarks coexist, the Trademark Office concluded that they are not confusingly similar to each other. In other words, “VEX” was found to be not confusingly similar to “SOLVEX” and “HI-VEX” and vice versa. If there is no consumer confusion between “VEX,” “HI-VEX,” and “SOLVEX,” all of which, if anything, are more similar to each other than the marks and goods in the present comparison, then the above is additional evidence that weighs in favor of finding that Applicant’s and Registrants’ Marks are not likely to cause consumer confusion. In the context of the instant Section 2(d) refusals,

there is no other logical conclusion than that confusion is unlikely between Applicant's mark and the subject mark of the Cited Registration.

#### **VI. Doubts Must Be Resolved In Applicant's Favor.**

For the above-stated reasons, it is unlikely that the co-existence of the Applicant's mark and the Cited Registrant's mark will lead to more than *de minimis* consumer confusion. Applicant has raised clear doubts about whether the marks are confusingly similar. The law states that doubts "should be resolved in Applicant's behalf..." *In re Aid Laboratories Inc.* 221 USPQ 1215, 1216 (TTAB 1993) (PEST PRUF not merely descriptive for animal shampoo with insecticide); *In re American Hospital Supply Corp.*, 219 USPQ 949 (TTAB 1983); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972). See also *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); and *In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974, 1976 (TTAB 1994).

Applicant, therefore, respectfully requests that the Examiner withdraw the Section 2(d) refusal of Applicant's application and allow the application to proceed to publication. If the Registrant believes that Applicant's substantially different mark in connection with substantially different goods that happen to coincide in International Classes 3 is likely to be confused with Registrant's mark, it will have the opportunity to oppose the registration.

#### **CONCLUDING REMARKS**

Applicant has responded to the Section 2(d) refusal raised by the Examining Attorney. In view of the foregoing, it is believed that the application is in condition for publication. Such action is respectfully requested.

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